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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/375,239	08/16/1999	EZIO MUSSO	P8910-9024	4809

7590 06/04/2003
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1050 Connecticut Avenue, N.W., Suite 600
Washington, DC 20036-5339

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/375,239

Applicant(s)

MUSSO ET AL.

Examiner

Rabon Sergent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 10, 12-17, 22-24, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-3, 12, 13, 23, 24 and 27 is/are rejected.
- 7) ☒ Claim(s) 10 and 14-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-3, 12, 13, 23, 24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klug et al. ('882 or '016 or '931).

Patentees disclose azeotropic compositions and their use as blowing agents for polyurethanes and polyolefins wherein compositions which correspond to applicants' compositions; IV, V, D, and E; are disclosed. See abstract.

3. While patentees are silent regarding applicants' claimed density value, the position is taken that it would have been obvious to one of ordinary skill to control foam density by

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adjusting such characteristics as the amount of blowing agent utilized. Such control amounts to the obvious adjustment or optimization of a result effective variable.

4. The responses of November 27, 2002 and March 13, 2003 and the 37 CFR 1.132 declaration of December 5, 2000 have been considered. In response, the position is maintained that the declaration is deficient, because the examples of the declaration are not commensurate in scope with the claims or the prior art. It is not seen that applicants' response has adequately addressed or corrected these deficiencies. Furthermore, applicants' argument that the compositions are inoperative as blowing agents for polyurethane foams is not well taken. In accordance with the provisions of MPEP 716.07, applicants' cited two examples where the foam did not expand does not amount to the preponderance of evidence required to rebut the patent's presumption of operability. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980).

Additionally, it is noted that the presumption of operability is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. *In re Weber*, 405 F.2d 1403, 160 USPQ 549 (CCPA 1969). Since it is presumed that skilled workers would make the necessary adaptations, within the capabilities of the skilled artisan, in order to arrive at the desired results, failures by experimenters who have no interest in succeeding should not be accorded great weight. *In re Michalek*, 162 F.2d 229, 74 USPQ 107 (CCPA 1947); *In re Reid*, 179 F.2d 998, 84 USPQ 478 (CCPA 1950).

5. Lastly, despite applicants' arguments, there is no definitive language that requires the blowing agents to be used in the same molar quantities as compared to the quantities used for

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CFC-11, in order for the blowing agents to substitute for CFC-11. Furthermore, apparently from the response, it is applicants' position that in order for the blowing agents, in question, to act as substitutes for CFC-11, the blowing agents must be able to perform their blowing function under the conditions required for CFC-11. This position is not set forth by the specification and would be considered unduly narrow or restrictive by one of ordinary skill in the art. The position is taken that one of ordinary skill in the art would consider the blowing agents to be substitutes for CFC-11 if the blowing agents could be used to produce viable foams which are comparable to foams produced from CFC-11, under virtually any conditions that can be practiced in industry. For the reasons set forth within paragraph 4, the position is taken that applicants' response and declaration have failed to establish that the teachings within the prior art, alone or in combination with the knowledge of the skilled artisan, are insufficient to guide one in the production of polyurethane foams having properties that one of ordinary skill in the art would consider as comparable to properties possessed by CFC-11 blown polyurethane foams.

6. Claims 22 and 26 are allowable.
7. Claims 10 and 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With respect to claim 10, the subject matter pertains only to species XII and XIII; therefore, the incorporation of the subject matter of claim 10 into claim 1 would have bearing only with respect to species XII and XIII of claim 1 and would not extend patentability to other species or aspects of claim 1.

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8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent
June 1, 2003


RABON SERGENT
PRIMARY EXAMINER